

Appl. No. 10/083,001
Amdt. dated October 5, 2004
Reply to Office Action of July 20, 2004

REMARKS

This is responsive to the Office Action dated July 20, 2004 in which claims 2, 4-26, 30 and 33 were allowed. Applicant greatly appreciates the allowance of these claims.

Claims 1, 3, 27-29 and 32 were rejected under 35 U.S.C. § 103 as allegedly being obvious over U.S. Patent No. 5,292,020 issued to Narin in view of U.S. Patent No. 4,349,116 issued to Luenser. Applicant respectfully traverses these rejections and requests reconsideration and allowance of those claims in light of the following comments.

The rejection alleges that the protruding member in the Narin closure is inherently configured to deflect due to the nature of plastic material. The rejection properly observes that Narin does not teach that the anti-backoff member has a width greater than its thickness, but that Luenser teaches an anti-backoff member having a width greater than its thickness. As a result, the rejection alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of a thinner, more flexible anti-backoff member having a width greater than its thickness to Narin since changing the shape of the member is an obvious matter of design choice for expedient manufacturing of the closure.

Applicant respectfully asserts that the § 103 rejection is improper and does not present a *prima facie* case of obviousness for a multitude of reasons. The rejection relies upon the fact that since the Narin closure is made of plastic, and plastic is inherently

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a flexible material, that the anti-backoff member in Narin is inherently flexible. Applicant respectfully disagrees and suggests that Narin explicitly teaches otherwise. The anti-backoff member disclosed in Narin is identified by reference numeral 44 in that patent and is particularly shown in Figs. 2-6 thereof. Applicant respectfully asserts that the anti-backoff member or rib 44 in Narin is not flexible and is not intended to deflect.

The rigid nature of the rib 44 in Narin is repeatedly and explicitly disclosed in Narin. For example, in col. 2, Ins. 31-34, Narin states: "The rib(s) are configured to abut against and provide a frictional retaining force to retard axial movement against the uppermost portion of the container threads." At col. 4, Ins. 17-20, Narin teaches that the rib 44 prevents "upward or downward axial movement of the closure." How could the rib deflect if it is intended to prevent upward and downward axial movement of the closure? Narin explicitly teaches that upward or downward axial movement of the closure is prevented and any deflection of the rib 44 is contrary to such teaching. At col. 5, Ins. 51-54, Narin teaches that the ribs 44 "securely abuts against" the container threads to prevent axial upward travel.

At col. 6, Ins. 1-4, the ribs are described as forming "a buttress against which the container 12 cannot travel up against." Applicant respectfully asserts that a rib which forms a buttress as explicitly taught in Narin does not deflect or bend. A buttress is commonly defined as something that serves to support, prop, strengthen or reinforce. A

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rib intended to buttress against a container is not one which someone of ordinary skill in the art would consider to be flexible or capable of deflecting.

Moreover, Fig. 2 shows the rib 44 in contact with the container thread; whereas, Figs. 4 and 6 of Narin show the rib when it is not in contact with the container thread. Importantly, the configuration of the thread in Figs. 2, 4 and 6 is identical thereby teaching someone of ordinary skill in the art that the rib 44 in Narin does not deflect when it is in contact with the container thread. The wide base, rounded contour and truncated height of the rib in Narin likewise indicates that such a structure is not intended to bend or deflect in response to contact with the container thread.

Therefore, Applicant respectfully asserts that Narin explicitly teaches someone skilled in the art that the rib is not a member that deflects or bends even though such member is made of plastic material. Applicant respectfully asserts that the general statement in the rejection that plastic is a material that inherently deflects is an oversimplification. While many plastic materials are intended to bend or deflect, such as the plastic anti-backoff members disclosed in Luenser and U.S. Patent No. 4,325,487 issued to Libit, not all plastic components are capable of bending or deflecting. Hard plastic materials clearly do not bend or deflect and Applicant respectfully asserts that the rib 44 in Narin is a plastic member which one of ordinary skill in the art would understand does not deflect or bend as explicitly taught in that reference.

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As a result, Applicant respectfully asserts that the rejection does not establish a *prima facie* case of obviousness. The USPTO bears the initial burden of presenting a *prima facie* case of obviousness and, if this burden is not met, the burden does not shift to Applicant to come forward with evidence or arguments to rebut the obviousness assertion. The *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. In other words, to properly combined references to make a *prima facie* case of obviousness, some teaching or suggestion in either one or both of the references is required, or knowledge generally available to one of ordinary skill in the relevant art which would have led one skilled in the art to combine the relevant teachings of the references.

Applying the law of obviousness to this case, there is absolutely no teaching, suggestion or disclosure to modify the Narin reference by including a flexible anti-backoff member as disclosed in Luenser. The critical question is whether there is something in the prior art references as a whole to suggest the desirability, and thus the obviousness of making the combination. There is no such suggestion in the Narin or Luenser references. The fact that the prior art may be modified in the way suggested in the rejection is not determinative of a proper obviousness-type rejection. The prior art must suggest the desirability of making the modification. The only suggestion in the rejection that the anti-backoff member or rib in Narin should be or could be replaced with the Luenser anti-

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backoff member is that plastic is inherently capable of deflection and therefore the deflecting member in Luenser could be utilized. Applicant has clearly demonstrated that, contrary to the alleged inherent teaching in Narin, the explicit and clear teaching in Narin is that the rib is not flexible. Therefore, for at least this reason, the rejection is improper and should be withdrawn.

The rejection is further improper because it uses impermissible hindsight to reconstruct Applicant's claimed invention. In other words, Applicant's claims have been used as a blue print to try and combine bits and pieces of the prior art together to make the § 103 rejection. A combination of prior art is improper and not obvious when the only suggestion or reason for combining the teachings of the prior art is found in the present application. The rejection tries to substantiate the combination by asserting that expedient manufacturing of the disclosure is motivation for making the substitution of the anti-backoff member in Luenser into the closure of Narin. Applicant respectfully asserts that the shape and configuration of the closure and rib in Narin is much more easily manufactured than the elongate, flexible and protruding anti-backoff member in Luenser. One of ordinary skill in the art would readily recognize that molding or otherwise producing a closure with the elongate, flexible and protruding anti-backoff member in Luenser would be a more difficult task than molding or otherwise manufacturing the closure and stubbly, low-profile, rigid rib of Narin.

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Finally, and most importantly, the rejection is improper because Narin explicitly teaches away from the present invention and the use of a flexible anti-backoff member. As previously demonstrated, Narin discloses a rigid, non-bending anti-backoff member rib and one of ordinary skill in the art would not be led to utilize a flexible backoff member such as in the present invention in light of the Narin reference.

The Narin reference teaches away from the use of a flexible anti-backoff member and teaching away is the antithesis of the art suggesting that the person of ordinary skill go in the claimed direction. Essentially, teaching away from the art is a per se demonstration of a lack of *prima facie* obviousness. Contrary to the assertion in the rejection that plastic is inherently configured to deflect, the Narin reference explicitly teaches that the rib or anti-backoff member therein is not intended and does not, in fact, deflect or bend. Combining the teaching of Luenser with respect to a flexible back-off member would destroy the intent, purpose and function of the invention disclosed in Narin. Such a proposed modification is not proper and a *prima facie* case of obviousness has not been made.

The prior art Narin reference requires modification of a flexible anti-backoff member to meet the claimed invention and doing so is movement in the opposite direction from the intent, purpose and function of the Narin invention. As a result, one of ordinary skill in the art would not combine the Narin and Luenser references as asserted in the rejection to arrive at Applicant's claimed invention. Therefore, Applicant respectfully

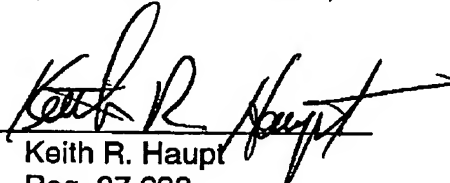
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asserts that a proper *prima facie* case of obviousness has not been presented in the rejection.

As a result of the remarks given herein, Applicant respectfully asserts that each of the rejections identified in the Office Action are improper. As such, Applicant respectfully requests reconsideration and allowance of claims 1-30 and 32-33 at the Examiner's earliest convenience. If the Examiner feels that any matter in this case requires further attention prior to issuing a Notice of Allowance, she is respectfully asked to telephone the undersigned attorney so that the matter may be promptly resolved.

Respectfully submitted,

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